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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,661	11/28/2000	Derek O'Hagan	1413.101	7716

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Intellectual Property - R440  
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EXAMINER

STUCKER, JEFFREY J

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 04/17/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/9/02
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-7, 9-19, 21, & 22 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-7, 9-19, 21, & 22 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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This Office Action is in response to the amendment filed 4/9/02. Claims 8 and 20 are canceled and claims 21 and 22 are added. Therefore, claims 1-7, 9-19, 21, and 22 are pending and under final rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claim 20 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter **is withdrawn** in view of the cancellation of the claim.

The rejection of claim 20 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention **is withdrawn** in view of the cancellation of the claim.

The rejection of claims 1-4, 9, 11, 12, and 14-19 and new claims 21 and 22 are rejected under 35 U.S.C. § 102(a) as being anticipated by Gombotz et al. (US 5,900,238) **is maintained**.

Applicant's arguments have been fully considered but are not deemed to be persuasive. Applicant cites several legal precedents

to bolster an argument that the reference does not specifically indicate that hyaluronic acid should be used. While the Office abides by the legal precedence as articulated by the courts, applicant's conclusion is in direct conflict with the explicit direction of the MPEP. See MPEP § 2131.02. The relevant portion is reproduced below for the convenience of the applicant:

**A REFERENCE THAT CLEARLY NAMES THE CLAIMED SPECIES ANTICIPATES THE CLAIM NO MATTER HOW MANY OTHER SPECIES ARE NAMED**

A genus does not always anticipate a claim to a species within the genus. **However, when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named.** *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described' as that term is used in 35 U.S.C. § 102(a), in that publication."). *Id.* at 1718. See also *In re Sivaramakrishnan*, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. **The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims** and because the claim was anticipated, the unexpected properties were immaterial.). [Emphasis added]

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., methods of making

the composition of claim 1) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, the instant invention is anticipated by Gombotz et al.

The rejection of claims 1-7, 9-19, 21, and 22 under 35 U.S.C. § 103(a) as obvious over Gombotz et al. (US 5,900,238) in view of both Partidos et al. (Immunology 1996) and Callegaro et al. (EP 0 517 565 A3) **is maintained.**

Applicant's arguments have been fully considered but are not deemed to be persuasive. Applicant argues that the primary reference does not provide an enabling disclosure and would not provide an expectation of success. This is not convincing for the reasons given above, namely, that the reference anticipates broad claims and is therefore, enabled. For the reasons set forth in the previous office action, it would have been obvious to combine it with the secondary references with the expectation of producing a mucosal vaccine.

Applicant's arguments concerning "improper rejection" are not understood. It is proper to reject a broad claim by the same

reference as anticipatory and in combination with a secondary reference as obvious with a narrow claim. By applicant's reasoning, a reference that is held to be anticipatory over a broad claim would also anticipate a narrow claim directed to a specie that was not disclosed in the reference.

Therefore, the instant invention is obvious over Gombotz et al. (US 5,900,238) in view of both Partidos et al. (Immunology 1996) and Callegaro et al.

No claims are allowed.

**THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Papers related this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of

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such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

The Group 1600 Fax numbers are: (703) 308-4242 and (703) 305-3014.

Unofficial communications may be faxed to: (703) 308-4426.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Stucker whose telephone number is (703) 308-4237. The examiner can normally be reached Monday to Thursday from 7:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to read "Jeffrey Stucker", written in a cursive style.

**JEFFREY STUCKER  
PRIMARY EXAMINER**